

ESTTA Tracking number: **ESTTA510717**

Filing date: **12/13/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Take-Two Interactive Software, Inc.
Granted to Date of previous extension	12/19/2012
Address	622 Broadway New York, NY 10012 UNITED STATES
Attorney information	Aryn M. Emert Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036-6799 UNITED STATES ame@cll.com, jzk@cll.com, mmh@cll.com, trademark@cll.com, sbi@cll.com Phone:212-790-9200

Applicant Information

Application No	78519244	Publication date	08/21/2012
Opposition Filing Date	12/13/2012	Opposition Period Ends	12/19/2012
Applicant	Rockstarz, Inc. 23 Treeview Circle Scotch Plains, NJ 07076 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: pre-recorded videos, CDs and DVDs featuring instructional programs for musicians

Grounds for Opposition

Other	Please see attached pleading.
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Attachments	NOO - ROCKSTARZ.pdf (10 pages)(30350 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Aryn M. Emert/
Name	Aryn M. Emert
Date	12/13/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/519,244

Filed: November 18, 2004

For Mark: ROCKSTARZ and Design

Published in the Official Gazette: August 21, 2012

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TAKE-TWO INTERACTIVE SOFTWARE, INC.,

Opposer,

Opposition No.

-against-

NOTICE OF OPPOSITION

ROCKSTARZ, INC.,

Applicant.

----- X

Commissioner for Trademarks

Attn: Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

TAKE-TWO INTERACTIVE SOFTWARE, INC. (“Take-Two” or “Opposer”), a Delaware corporation, with a business address at 622 Broadway, New York, New York 10012, believes it will be damaged by registration of the mark ROCKSTARZ and Design, shown in Application Serial No. 78/519,244, for “pre-recorded videos, CDs and DVDs featuring instructional programs for musicians” in International Class 9, and having been granted an extension of time to oppose up to and including December 19, 2012, hereby opposes the same.

As grounds of opposition, Take-Two alleges as follows:

1. Take-Two is a leading worldwide publisher, developer and distributor of interactive entertainment software, hardware and accessories, including video and computer games and online interactive video games, interactive video and online entertainment services, and related accessories, products and services.

2. As set forth in detail below, Opposer, through its affiliated companies, offers such goods and services under trade names, trademarks and service marks comprising or containing the term ROCKSTAR and the letter “R” combined with a star design, used alone or with other words or designs (collectively, “Opposer’s ROCKSTAR Marks”). The iteration of Opposer’s ROCKSTAR Marks combining an R and a star design (the “R & Star Design Mark”) denotes and is understood by consumers to stand for the word “Rockstar.”

3. Take-Two is the parent company of the world famous video game developer Rockstar Games, Inc. (“Rockstar”). Rockstar has conducted business under the names and marks ROCKSTAR GAMES and ROCKSTAR since 1998, long prior to any constructive use date claimed in the application herein opposed. Rockstar uses the ROCKSTAR house mark for each of its subsidiary development studios, including Rockstar North, Rockstar London, Rockstar Leeds, Rockstar Lincoln, Rockstar San Diego, Rockstar Vancouver, Rockstar Toronto and Rockstar New England. Rockstar also uses the ROCKSTAR house mark for numerous products and services, including ROCKSTAR PASS (subscription software package), ROCKSTAR GAMES SOCIAL CLUB (online services), ROCKSTAR FILMS (television and movie production), ROCKSTAR WAREHOUSE (online sales), and ROCKSTAR LOFT (entertainment events).

4. Beginning in 1999, Opposer, through its Rockstar subsidiary, has used Opposer’s ROCKSTAR Marks to designate its world famous entertainment software, computer and video games and related products and services. These products marketed in connection with Opposer’s ROCKSTAR Marks include some of the best-selling video games in the world, including the GRAND THEFT AUTO, RED DEAD, MIDNIGHT CLUB, and MAX PAYNE series of video games. The GRAND THEFT AUTO series of games alone have collectively sold well over 125

million copies, and Rockstar is one of the best recognized and most successful game developers in the world. As an example of how popular Rockstar is, and how well known Opposer's ROCKSTAR Marks are, a Google search for the words ROCKSTAR, VIDEO and GAMES performed on December 13, 2012 resulted in more than 21,000,000 hits.

5. Since adopting Opposer's ROCKSTAR Marks, Opposer has also expanded use of such marks to a broad variety of other products and services, including without limitation printed entertainment materials such as magazines, manuals, guides, periodicals, pamphlets, and books; clothing and retail services featuring clothing; prerecorded digital music files and sound recordings; retail services featuring music; online streaming of music; music publishing services; and providing downloadable music, ringtones, graphics, and wallpaper for mobile phones.

6. Opposer also operates an online store designated ROCKSTAR WAREHOUSE. Through this store, located at www.rockstarwarehouse.com, Opposer sells and distributes promotional products bearing Opposer's ROCKSTAR Marks.

7. Opposer has continuously and prominently used Opposer's ROCKSTAR Marks since their adoption. Opposer has extensively advertised and promoted Opposer's ROCKSTAR Marks in connection with the many businesses described above, and has achieved significant sales, exposure and recognition of the above described goods and services bearing Opposer's ROCKSTAR Marks.

8. By virtue of Opposer's longstanding use, advertisement and promotion of Opposer's ROCKSTAR Marks and the goods and services they designate, these marks have developed enormous goodwill in the trade and among consumers and have become famous and associated in the mind of the public with Opposer's well-known products and services.

9. Opposer owns numerous federal trademark registrations and applications for Opposer's ROCKSTAR Marks, including without limitation:

- a. Registration No. 2,456,387 for ROCKSTAR GAMES for "computer games software and video game programs," which issued May 29, 2001, and has achieved incontestable status;
- b. Registration No. 2,855,543 for R ROCKSTAR GAMES and Design for "computer game software and video game programs," which issued June 22, 2004, and has achieved incontestable status;
- c. Registration No. 4,037,654 for ROCKSTAR GAMES for "animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes; computer and video game software, and related programs and software, namely, screensavers, digital music files, videos, films and other multimedia materials, all featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes, all delivered via pre-recorded discs and other pre-recorded media and via downloadable delivery on global computer networks and wireless networks; pre-recorded discs and other prerecorded digital and electronic media in the field of live action programs, motion pictures, or animation featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes," and "entertainment services, namely, providing a website featuring use of non-downloadable computer and video games, and news, information, tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, television programs, animated series, and other multimedia materials, all non-downloadable and all in the field of computer games and video games; providing information, news and commentary in the field of computer games and video games," which issued October 11, 2011;
- d. Registration No. 3,956,407 for ROCKSTAR LOFT for "arranging and conducting special events and parties," which issued on May 10, 2011;
- e. Registration No. 3,956,411 for ROCKSTAR WAREHOUSE and Design for "online retail store services featuring computer games, DVDs, posters, printed publications, bags, toys and apparel, namely, shirts, t-shirts, sweatshirts, casual and leisure jackets, and headgear, namely, hats and caps," which issued on May 10, 2011;
- f. Application No. 85/419,485 for ROCKSTAR STUDIOS for "Computer and video game programs and software; downloadable computer and video game programs and software; downloadable digital materials namely, ring tones, wallpapers, screensavers, digital music files, and graphics, videos, films, multimedia files, animated films in the field of

video games and computer games, all delivered via global computer networks and wireless networks; pre-recorded digital media featuring computer games and video games, ring tones, wallpapers, screensavers, digital music files, and graphics, videos, films, multimedia files, animated films in the field of video games and computer games; and pre-recorded video discs and other pre-recorded digital and electronic media in the field of live action programs, motion pictures, or animation featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes” and “printed materials, namely, books, pamphlets, periodicals, magazines, and manuals in the field of video games; posters,” and “clothing, headgear, and footwear” and “entertainment services, namely, providing online games, providing a website featuring nondownloadable computer and video games, and news, information, tips, hints, contests, computer enhancements for games, audiovisual content, music, films, videos, television programs, animation and other multimedia materials in the field of computer games and video games; providing information, news and commentary in the field of computer games and video games; and animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes,” which was filed on September 9, 2011;

- g. Application No. 85/487,482 for R ROCKSTAR GAMES and Design for “clothing, namely, shirts, t-shirts, sweatshirts, pants, casual and leisure jackets; headgear, namely, hats and caps,” which was filed on December 5, 2011
- h. Registration No. 2,391,635 for the R & Star Design Mark for “computer game software and video game programs,” which issued October 3, 2000;
- i. Registration No. 3,351,855 for the R & Star Design Mark for “entertainment software, namely, game discs and downloadable game software for use with personal computers, video game consoles, hand held gaming devices,” which issued December 11, 2007;
- j. Registration No. 3,631,311 for the R & Star Design Mark for “men, women and children's clothing, namely, shirts, t-shirts, sweatshirts, casual and leisure jackets; headgear, namely, hats and caps,” which issued June 2, 2009;
- k. Registration No. 3,619,405 for the R & Star Design Mark for “downloadable music, ringtones, graphics, and wallpaper via the Internet and mobile devices” and “on-line retail store services featuring downloadable sound, music, image, video and game files,” which issued May 12, 2009;

- l. Registration No. 3,616,037 for the R & Star Design Mark for “printed matter, namely books, pamphlets, strategy guides and manuals in the field of video games; posters; stickers,” which issued May 5, 2009;
- m. Registration No. 3,695,041 for the R & Star Design Mark for “arranging and conducting special events and parties,” which issued October 13, 2009;
- n. Registration No. 3,843,554 for the R & Star Design Mark for “entertainment services; provision of online entertainment; providing online computer games and online video games; providing information on entertainment in the field of computer games and video games; production of multimedia for entertainment purposes; design and production of computer games, video games and software for entertainment purposes; computer programming services; production and distribution of motion pictures,” which issued September 7, 2010;
- o. Registration No. 3,950,918 for the R & Star Design Mark for “sound recordings featuring music and digital music downloadable for the internet and wireless devices,” which issued April 26, 2011;
- p. Registration No. 3,992,563 for the R & Star Design Mark for “entertainment services, namely, providing on-line prerecorded nondownloadable, music, films, and movies via a global computer network,” which issued July 12, 2011;
- q. Registration No. 4,034,074 for the R & Star Design Mark for “animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes; computer and video game programs and software, and related programs and software, namely, screensavers, digital music files, videos, films and other multimedia materials, all featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes, all delivered via pre-recorded discs and other pre-recorded media and via downloadable delivery on global computer networks and wireless networks; pre-recorded discs and other pre-recorded digital and electronic media in the field of live action programs, motion pictures, or animation featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes,” and “entertainment services, namely, providing online computer and video games, providing a website featuring use of nondownloadable computer and video games, and news, information, tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, television programs, animated series, and other multimedia materials, all non-downloadable and all in the field of computer games and video games; providing information, news and commentary in the field of computer games and video games,” which issued on October 4, 2011.

- r. Registration No. 4,216, 755 for the R & Star Design Mark for “games, toys, and playthings, namely, dolls, toy action figures and accessories therefor,” which issued on October 2, 2012.

10. The above applications and registrations are valid and subsisting, and are in full force and effect and are owned by Opposer.

11. On November 18, 2004, applicant Rockstarz, Inc. (“Applicant”) filed Application Serial No. 78/519,244 (the “Application”), on an intent-to-use basis, to register the mark ROCKSTARZ and Design (“Applicant’s Mark”) for “pre-recorded videos, CDs and DVDs featuring instructional programs for musicians” in International Class 9.

12. Upon information and belief, Applicant did not use Applicant’s Mark in United States commerce in connection with the goods covered by the Application prior to its constructive first use date of November 18, 2004.

13. By virtue of Opposer’s prior use and promotion of and registrations for Opposer’s ROCKSTAR Marks, Opposer has rights in Opposer’s ROCKSTAR Marks prior and superior to any alleged rights of Applicant in Applicant’s Mark covered by the Application.

14. The goods covered by the Application are identical and/or closely related to goods bearing and services offered in connection with Opposer’s ROCKSTAR Marks. Opposer’s primary goods are software programs recorded on CD and DVD media in International Class 9; Applicant has applied for “CDs and DVDs featuring instructional programs” in International Class 9. In addition, Opposer uses and owns registrations for its ROCKSTAR Marks in connection with prerecorded digital music files, sound recordings, retail services relating to music and related goods and services.

15. The use of ROCKSTAR in Applicant’s Mark is closely and confusingly similar to the dominant “Rockstar” element of Opposer’s ROCKSTAR Marks. Additionally, just as Opposer prominently uses its R & Star Design Mark as part of its family of ROCKSTAR Marks

and to denote the term “Rockstar,” Applicant’s Mark combines the term “Rockstar” with the image of a star.

16. Applicant’s Mark so resembles Opposer’s ROCKSTAR Marks as to be likely, when applied to Applicant’s goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant’s goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would therefore be injured by the granting to Applicant of a certificate of registration for Applicant’s Mark.

17. Opposer’s ROCKSTAR Marks are distinctive and famous and enjoyed such fame well prior to November 18, 2004, Applicant’s constructive first use date. Opposer would be further injured by the granting of a certificate of registration for Applicant’s Mark, because such mark is likely to dilute the distinctive quality of Opposer’s Marks and impair the distinctiveness of Opposer’s ROCKSTAR Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant’s Mark and respectfully requests that its opposition be sustained and that the application for said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Jonathan Z. King, Midge Hyman, Aryn M. Emert and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Dated: New York, New York
December 13, 2012

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys For Opposer

By: /Aryn M. Emert/
Jonathan Z. King
Midge Hyman
Aryn M. Emert

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on December 13, 2012, I caused a true and complete copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant addressed as follows:

Rockstarz, Inc.
Owner Address: 23 Treeview Circle
Scotch Plains, NJ 07076

and Applicant's Attorney and Correspondent of Record:

Francine Miller
Dononvan & Yee LLP
110 Greene St., Ste. 700
New York, NY 10012-3838

Dated: New York, New York
December 13, 2012

/Aryn M. Emert/
Aryn M. Emert